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601 Applicant May Be Represented by Attorney at Law

The owner of a mark may file and prosecute his or her own application for registration of the mark, or may be represented by a practitioner qualified under 37 C.F.R. §10.14 to practice before the United States Patent and Trademark Office (“USPTO”) in trademark cases. 37 C.F.R. §§2.11 and 10.14. See TMEP §602 regarding persons who may practice before the USPTO in trademark cases. If the applicant is represented by a practitioner qualified under 37 C.F.R. §10.14 to practice before the USPTO in trademark cases, the USPTO will communicate only with the practitioner, unless that representation is terminated. If the applicant contacts the USPTO regarding the application, the applicant will be advised that the USPTO will only discuss the matter with applicant's attorney. See TMEP §602.04 regarding revocation of a power of attorney.

601.01 USPTO Cannot Aid in Selection of Attorney

The USPTO cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

If it is apparent that an applicant is unfamiliar with the proper preparation and prosecution of an application and needs more detailed or technical assistance than the examining attorney is permitted to give, the examining attorney may suggest to the applicant that it may be desirable to employ an attorney who is familiar with trademark matters. The following language may be used in the Office action:

The applicant may wish to hire a trademark attorney because of the technicalities involved in the application. The United States Patent and Trademark Office cannot aid in the selection of an attorney.

602 Persons Who May Practice Before Office in Trademark Matters

37 C.F.R. §10.14. Individuals who may practice before the Office in trademark and other non-patent cases.

(a) Attorneys. Any individual who is an attorney may represent others before the Office in trademark and other non-patent cases. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent cases.

(b) Non-lawyers. Individuals who are not attorneys are not recognized to practice

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before the Office in trademark and other non-patent cases, except that individuals not attorneys who were recognized to practice before the Office in trademark cases under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark cases.

(c) Foreigners. Any foreign attorney or agent not a resident of the United States who shall prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, provided: The patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.

(d) Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.

(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office.

United States Attorneys

An attorney who is a member in good standing of the bar of any United States court or the highest court of any State may practice before the USPTO in trademark matters. No application for recognition to practice is necessary. The USPTO does not give an examination for eligibility or maintain a register of persons entitled to practice in trademark cases. An attorney at law who appears in person or signs a document on behalf of an applicant or registrant will be accepted as the representative of the applicant or registrant. 37 C.F.R. §§2.17(a) and (c).

Only individuals, not law firms, are entitled to be recognized to represent others. Generally, attorneys who have not specifically been mentioned in either a power of attorney or in correspondence filed with the USPTO may discuss but not conclude business with the USPTO over the telephone. However, if an attorney from the same firm as the attorney of record claims to be authorized by the attorney of record to conduct discussions with respect to a specific application, the examining attorney will permit the attorney to conclude business, and will note this fact in any resulting

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Office action.

Foreign Attorneys

Under 37 C.F.R. §10.14(c), a foreign attorney who is not a resident of the United States may represent parties located in the country in which the foreign attorney resides and practices, if (1) he or she proves to the satisfaction of the USPTO'S Office of Enrollment and Discipline ("OED") that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices; and (2) the patent or trademark office of that foreign country allows substantially reciprocal privileges to those permitted to practice before the USPTO. A foreign attorney who meets the requirements of 37 C.F.R. §10.14(c) can only represent parties located in the country in which the foreign attorney resides and practices. The foreign attorney cannot represent parties located in the United States or other foreign countries.

Currently, Canadian attorneys are the only foreign attorneys recognized as meeting the qualification criteria of 37 C.F.R. §10.14(c). OED maintains a list of attorneys who are registered or in good standing with the Canadian Intellectual Property Office, which is available to USPTO employees through the USPTO's internal computer network. When a Canadian attorney represents a party in a proceeding in the USPTO, the examining attorney should verify that the attorney is in fact recognized by the Director of OED.

An attorney who resides and practices in a foreign country other than Canada and who is not a member in good standing of the bar of a United States court or the highest court of any State may not practice before the USPTO. Any such attorney who wishes to represent an applicant in a trademark matter must file a written request to do so with OED. This request should include proof that the attorney is in good standing with the foreign patent or trademark office, and that the foreign patent or trademark office provides substantially reciprocal rights to United States attorneys.

See TMEP §603.05 regarding correspondence with parties not domiciled in the United States, and TMEP §602.03 regarding papers filed by unauthorized persons.

Non-Attorneys

Non-attorneys are not permitted to practice except under the limited circumstances specified in 37 C.F.R. §10.14(b).

When an applicant is represented by counsel, the USPTO encourages the practice of direct communication with the appointed attorney(s). Although paralegals and legal assistants may convey information between the examining attorney and the appointed attorney(s), they are not authorized to conduct business before the

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USPTO. 37 C.F.R. §10.14(b). For example, a non-attorney who is authorized to verify facts on behalf of an applicant under 37 C.F.R. §2.33(a)(2) (see TMEP §804.04) may not sign responses to Office actions, or authorize examiner's amendments and priority actions, unless he or she has legal authority to bind the applicant (e.g., a corporate officer or partner of a partnership). See 37 C.F.R. §§10.14(e) and 10.18(a). See also TMEP §§712.01 *et seq.* for more information about persons who can sign responses to Office actions, TMEP §§707 *et seq.* regarding examiner's amendments, and TMEP §§708 *et seq.* regarding priority actions. Paralegals and legal assistants are not authorized to negotiate, argue a position, officially accept or reject Office requirements, or otherwise prosecute a matter before the USPTO.

Use of the term “agent” in connection with a representative in a trademark case is only appropriate under the limited circumstances specified in 37 C.F.R. §10.14(b).

602.01 Powers of Attorney

37 C.F.R. §2.17(c). To be recognized as a representative, an attorney as defined in §10.1(c) of this chapter may file a power of attorney, appear in person, or sign a document on behalf of an applicant or registrant that is filed with the Office in a trademark case.

37 C.F.R. §2.17(d) A party may file a power of attorney that relates to more than one trademark application or registration, or to all existing and future applications and registrations of that party. A party relying on such a power of attorney must:

- (1) Include a copy of the previously filed power of attorney; or*
- (2) Refer to the power of attorney, specifying the filing date of the previously filed power of attorney; the application serial number (if known), registration number, or inter partes proceeding number for which the original power of attorney was filed; and the name of the party who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date.*

Generally, it is not necessary for an attorney at law to file a power of attorney or any other special authorization in a trademark case. An attorney at law who appears in person or signs a document on behalf of an applicant or registrant will be accepted as the representative of the applicant or registrant. 37 C.F.R. §§2.17(a) and (c).

If an attorney files a proper power of attorney from the party he or she represents, the USPTO will accept the power. To be acceptable as a power of attorney, the power must identify an individual attorney(s) by name, not merely specify the name of a law firm. If a power specifies only the name of a law firm, the USPTO will treat it

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as a correspondence address rather than an authorization to conduct business. See TMEP §§603 *et seq.* regarding the correspondence address.

To expedite processing, the USPTO recommends that powers of attorney be filed through Trademark Electronic Application System (“TEAS”), at <http://www.uspto.gov/teas/index.html>. When powers of attorney are filed electronically, the data is automatically entered into the USPTO’s Trademark Reporting and Monitoring (“TRAM”) System.

An attorney cannot sign an original power of attorney on behalf of his or her client. An original power of attorney, other than one associating an additional attorney with an already authorized attorney (see TMEP §602.01(b)), must be signed by the individual applicant, or by someone with legal authority to bind a juristic applicant (e.g., a corporate officer or partner of a partnership). See TMEP §804.05 regarding signature of documents transmitted electronically.

If a power of attorney is signed by an improper person (e.g., the applicant’s attorney), the examining attorney generally does not have to require a properly signed power, because the filing of a power of attorney is not mandatory in a trademark case. See 37 C.F.R. §2.17(c). (However, if an applicant is already represented by an attorney, and a new attorney takes over, the applicant must file either a new power of attorney or a written request to change the correspondence address, signed by the applicant, before the USPTO will correspond with the new attorney. See TMEP §603.02(a). See *also* TMEP §602.03 regarding papers filed by unauthorized parties.)

If no power of attorney is filed, the USPTO will presume that an attorney is the attorney of record in an application if: (1) the original application is accompanied by a cover letter or transmittal letter that is signed by an attorney and identifies the name and address of that attorney; (2) the application is filed electronically using TEAS (see TMEP §301), and the attorney information section is completed; or (3) the application is filed by a *pro se* applicant (i.e., an applicant who does not have an attorney), and correspondence is subsequently filed that is signed by an attorney and identifies the name and address of that attorney, either on the correspondence itself or on the transmittal letter that accompanies the correspondence. The USPTO presumes that documents filed by practitioners are authorized to be filed.

The USPTO considers a power of attorney to end with respect to a particular application when the mark is registered, when ownership changes, or when the application is abandoned. See TMEP §602.01(c) regarding the processing of powers of attorney filed after registration.

If an attorney is suspended or excluded by the Director of the USPTO, a power of attorney should be regarded as void as of the date of suspension or exclusion, and no oral or written communication should be made with the attorney on or after that

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date. Any correspondence filed by a suspended or excluded attorney should be treated as correspondence filed by an unauthorized person, pursuant to TMEP §602.03.

See *also* TMEP §602.04 regarding revocation of a power of attorney, and TMEP §§603.02 *et seq.* regarding changes in the correspondence address.

602.01(a) Power of Attorney Relating to More Than One Application or Registration

Using TEAS, at www.uspto.gov/teas/index.html, an owner may appoint an attorney for up to 20 applications or registrations that have the identical owner and attorney. A power of attorney relating to future applications cannot be filed through TEAS.

An applicant or registrant may file a power of attorney *on paper* that relates to more than one trademark application or registration, or to all existing and future applications and registrations. Someone relying on such a power of attorney must: (1) include a copy of the previously filed power of attorney; or (2) refer to the previously filed power of attorney, specifying: the filing date of the power; the application serial number (if known), registration number, or *inter partes* proceeding number for which the original power of attorney was filed; and the name of the party who signed the power of attorney; or, if the application serial number is not known, submit a copy of the application or a copy of the mark, and specify the filing date. 37 C.F.R. §2.17(d). If the applicant or registrant meets these requirements, the examining attorney should accept the power of attorney.

602.01(b) Associate Powers of Attorney

Once the applicant has designated an attorney, the attorney may sign an associate power of attorney appointing another attorney as an additional person authorized to prosecute the application. If the applicant revokes the original power of attorney, this revocation also discharges any associate power signed by the attorney whose power has been revoked. See TMEP §602.04 regarding revocation of a power of attorney.

602.01(c) Powers of Attorney Filed After Registration

To expedite processing, the USPTO recommends that powers of attorney be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. When a power of attorney is filed through TEAS, the data is automatically entered into the USPTO's TRAM database.

The USPTO considers a power of attorney to end with registration.

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When a new power of attorney is filed *on paper* after registration, the USPTO scans an image of the document into the record, but does not change the attorney of record in the TRAM database unless the owner of the registration concurrently files an affidavit of continued use under 15 U.S.C. §1058 (“§8 affidavit”), affidavit of incontestability under 15 U.S.C. §15 (“§15 affidavit”), renewal application under 15 U.S.C. §1059, or request to amend or correct the registration under 15 U.S.C. §1057(e). Likewise, when the owner of a registration files a *paper* request to revoke a power of attorney, or an attorney files a request to withdraw as attorney of record, the USPTO scans an image of the document into the record but does not change the attorney of record in TRAM. See TMEP §602.04 regarding revocation of powers of attorney and TMEP §602.05 regarding withdrawal.

When the owner of a registration files an affidavit, renewal application, or request to amend or correct a registration through an attorney, the USPTO will update TRAM to indicate the name of the attorney who filed the affidavit, renewal application, or amendment.

See *also* TMEP §1612.

602.02 Standards of Conduct

37 C.F.R. §10.15. Refusal to recognize a practitioner. Any practitioner authorized to appear before the Office may be suspended or excluded in accordance with the provisions of this part. Any practitioner who is suspended or excluded under this subpart or removed under section 10.11(b) shall not be entitled to practice before the Office.

37 C.F.R. §10.20. Canons and Disciplinary Rules.

(a) Canons are set out in §§10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110. Canons are statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession.

(b) Disciplinary Rules are set out in §§10.22 - 10.24, 10.31 - 10.40, 10.47 - 10.57, 10.62 - 10.68, 10.77, 10.78, 10.84, 10.85, 10.87 - 10.89, 10.92, 10.93, 10.101 - 10.103, 10.111, and 10.112. Disciplinary Rules are mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action.

Part 10 of Title 37 of the Code of Federal Regulations pertains to representation of others before the USPTO. Part 10 identifies and defines individuals entitled to practice before the USPTO, and establishes a mandatory Code of Professional Responsibility, and defines a procedure for investigations and disciplinary proceedings.

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602.02(a) Signature and Certificate for Correspondence filed in the United States Patent and Trademark Office

37 C.F.R. §10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or §2.193(c)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that-

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice

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and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of-

- (1) Holding certain facts to have been established;*
- (2) Returning papers;*
- (3) Precluding a party from filing a paper, or presenting or contesting an issue;*
- (4) Imposing a monetary sanction;*
- (5) Requiring a terminal disclaimer for the period of the delay; or*
- (6) Terminating the proceedings in the Patent and Trademark Office.*

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See §10.23(c)(15).

602.03 Papers Filed by Unauthorized Persons

Under 37 C.F.R. §10.18(a), every document filed by a practitioner qualified under 37 C.F.R. §10.14 to practice before the USPTO in trademark cases (except for papers required to be signed by the applicant, registrant or party to a proceeding) must be personally signed by the practitioner. The signature constitutes a certificate that the document's filing is authorized. 37 C.F.R. §10.18(b)(1). Therefore, the USPTO presumes that papers signed by practitioners are authorized to be filed and will enter such papers in the record.

An individual who is not qualified under 37 C.F.R. §10.14(a), (b), or (c) to practice before the USPTO in trademark cases is not permitted to represent a party in the prosecution of a trademark application, maintenance of a registration, or in a proceeding before the USPTO. 5 U.S.C. §500(d); 37 C.F.R. §10.14(e). If the examining attorney suspects that an individual who does not meet the requirements of 37 C.F.R. §10.14 is representing an applicant, the examining attorney should bring the matter to the attention of the Administrator for Trademark Policy and Procedure in the Office of the Commissioner for Trademarks, who will coordinate appropriate action with the Office of Enrollment and Discipline.

If it appears that a response to an Office action was signed by an improper party, the examining attorney should treat the response as an incomplete response, and should grant the applicant additional time to perfect the response, pursuant to 37 C.F.R. §2.65(b) and TMEP §718.03(b). The applicant must submit a response signed by someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or by an attorney who is qualified to practice under 37 C.F.R. §10.14. Where a response was signed by an unauthorized party, it is not acceptable for the applicant to ratify the response through an examiner's amendment. See TMEP §712.03.

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602.04 Revocation of Power of Attorney

37 C.F.R. §2.19(a). Authority to represent an applicant, registrant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon written notification to the Director; and when it is revoked, the Office will communicate directly with the applicant, registrant or party to the proceeding, or with the new attorney or domestic representative if one has been appointed. The Office will notify the person affected of the revocation of his or her authorization.

An applicant may revoke a power of attorney by filing a written revocation. The USPTO will acknowledge the revocation and will no longer recognize the attorney in that case unless he or she is again specifically appointed.

To expedite processing, the USPTO recommends that revocations of powers of attorney be filed through TEAS, at <http://www.uspto.gov/teas/index.html>.

When an applicant is represented by an attorney, a change in representation can be made only by a written request signed by the applicant. If the applicant files a new power of attorney, the address contained in the new power of attorney becomes the correspondence address of record. If the applicant files a revocation of the previous power of attorney without a new power of attorney, correspondence will be sent either to (1) the applicant, or (2) the attorney signing the cover letter or action accompanying the revocation.

The new attorney cannot sign a new power of attorney or revocation of the previous power of attorney on behalf of the applicant. The revocation must be signed by the individual applicant, or by someone with legal authority to bind a juristic applicant (e.g., a corporate officer or partner of a partnership).

The USPTO considers a power of attorney to end with registration. After registration, if the owner of a registration files a *paper* request to revoke a power of attorney appointed before registration, the USPTO scans an image of the revocation into the record but does not change the attorney of record in TRAM unless the owner concurrently files a §8 or §15 affidavit, §9 renewal application, or request to amend or correct the registration under §7 of the Act. See TMEP §1612.

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602.05 Permissive Withdrawal of Attorney of Record

37 C.F.R. §2.19(b). If the requirements of §10.40 of this chapter are met, an attorney authorized under §10.14 to represent an applicant, registrant or party in a trademark case may withdraw upon application to and approval by the Director.

An attorney may withdraw from representing an applicant or registrant, but may not withdraw in a way that would prejudice the applicant or registrant. *In re Legendary, Inc.*, 26 USPQ2d 1478 (Comm'r Pats. 1992) (attorney's request to withdraw denied where the request was filed on the last day of the period for response to an Office action and attorney stated neither that the applicant was given due notice of the attorney's withdrawal from employment nor that the attorney had delivered all papers and property in his file concerning the prosecution of the application to the applicant). See 37 C.F.R. §10.40 regarding mandatory and permissive withdrawal from employment by an attorney.

To expedite processing, the USPTO recommends that requests to withdraw as the attorney of record prior to registration be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. Requests to withdraw as attorney cannot be filed through TEAS after registration.

Before registration, a request for permission to withdraw as attorney will be handled by the appropriate managing attorney, or, if a notice of allowance has issued and the application is awaiting the filing of a statement of use, by the Supervisor of the ITU/Divisional Unit. After registration, a request for permission to withdraw as attorney will be handled by the Supervisor of the Post Registration Section of the Office.

A request to withdraw must include the following:

- (1) A statement of the reason(s) for the request to withdraw (see 37 C.F.R. §10.40);
- (2) A statement that the attorney has given due notice to the applicant or registrant that the attorney is withdrawing from employment and will be filing the necessary papers with the USPTO; and that the applicant or registrant was given notice of the withdrawal at least two months before the expiration of the response period;
- (3) A statement that the attorney has delivered to the applicant or registrant all papers and property in the attorney's file concerning the prosecution of the application or registration; and
- (4) A statement that the attorney notified the applicant or registrant of any responses that may be due, and of the deadline for response.

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A request to withdraw should be filed soon after the representative notifies the applicant or registrant of his or her intent to withdraw. If an applicant or registrant was notified of the attorney's withdrawal from employment at least two months before the expiration of the response period, and the request to withdraw meets all the requirements listed above, the request will be granted. *In re Slack*, 54 USPQ2d 1504 (Comm'r Pats. 2000).

The request for permission to withdraw should also contain the following:

- (1) The application serial number or registration number;
- (2) The law office to which the application is assigned, in a pending application;
- (3) The name of the examining attorney or Post Registration examiner assigned; and
- (4) The present mailing address of the attorney who is withdrawing and the present mailing address of the applicant or registrant.

If filed on paper, the request should be titled "Request for Permission to Withdraw as Attorney of Record."

The managing attorney or supervisor will approve or deny the request, notify the applicant or registrant and the attorney of the approval or denial of the request, and place a record of this notification (*i.e.*, a copy of the written communication or telephone call record) in the record. If the request is approved, the managing attorney or supervisor should ensure that the correspondence address is changed in the USPTO's automated records. It is the responsibility of the managing attorneys or supervisors to establish procedures that permit withdrawal requests to be given priority and acted on promptly.

If the attorney who seeks to withdraw is also the domestic representative, the managing attorney or supervisor should inquire as to whether the attorney intends to withdraw as domestic representative. This inquiry should be made by phone or e-mail, if possible. If the attorney withdraws as domestic representative, the managing attorney or supervisor should ensure that the domestic representative field in TRAM is updated accordingly. See TMEP §604 regarding designations of domestic representative, and TMEP §603.05 regarding correspondence with parties not domiciled in the United States.

If an attorney appointed before registration files a request to withdraw after registration, the USPTO scans an image of the request into the record but does not change the attorney of record in TRAM. See TMEP §§602.01(c) and 1612.

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The USPTO will not process a request for permission to withdraw in an abandoned application. When an attorney files a request to withdraw in an abandoned application, the USPTO scans an image of the request into the record but does not change the TRAM database. See TMEP §1612.

603 Correspondence, With Whom Held

37 C.F.R. §2.18 Correspondence, with whom held.

(a) If documents are transmitted by an attorney, or a written power of attorney is filed, the Office will send correspondence to the attorney transmitting the documents, or to the attorney designated in the power of attorney, provided that the attorney is an attorney as defined in §10.1(c) of this chapter.

(b) The Office will not undertake double correspondence. If two or more attorneys appear or sign a document, the Office's reply will be sent to the address already established in the record until the applicant, registrant or party, or its duly appointed attorney, requests in writing that correspondence be sent to another address.

(c) If an application, registration or proceeding is not being prosecuted by an attorney but a domestic representative has been appointed, the Office will send correspondence to the domestic representative, unless the applicant, registrant or party designates in writing another correspondence address.

(d) If the application, registration or proceeding is not being prosecuted by an attorney and no domestic representative has been appointed, the Office will send correspondence directly to the applicant, registrant or party, unless the applicant, registrant or party designates in writing another correspondence address.

603.01 Establishing the Correspondence Address

When a trademark application is filed, the USPTO enters into its automated records an address (consisting of a name, street address or post office box, city, state and postal code) where correspondence from the USPTO will be sent. This often differs from the applicant's address. Correspondence will be sent to any address within the United States that the applicant selects. The USPTO will send correspondence to Canada if the applicant selects a Canadian attorney or agent who is duly qualified under 37 C.F.R. §10.14(c) to practice before the USPTO (see TMEP §602). See TMEP §603.05 regarding correspondence with applicants who are not domiciled in the United States, and TMEP §603.01(a) regarding correspondence in §66(a) applications.

The USPTO may send communications concerning an application by e-mail if e-mail communication is authorized by the applicant or the applicant's attorney. See TMEP §304.03.

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When the application includes a power of attorney that designates an attorney(s) and an address, or a form that has the appearance of a power of attorney that designates the name and address of an attorney, the USPTO will correspond with the designated attorney. In addition, the USPTO will presume that the applicant wishes correspondence to be sent to an attorney's address rather than directly to the applicant when:

- (1) The name and address of an attorney appears in the original application papers;
- (2) The original application is accompanied by a transmittal letter on letterhead that identifies an attorney;
- (3) The application is filed through TEAS (see TMEP §301), and the attorney information section is completed; or
- (4) The original application is written on paper that identifies the name and address of an attorney.

The above procedures are also used to establish the correspondence address when a registrant files a §8 or §71 affidavit, §9 renewal application, or request for amendment or correction of a registration under 15 U.S.C. §1057. The USPTO will update TRAM to indicate the name of the attorney who filed the affidavit, renewal application, or amendment.

See TMEP §603.02(a) for information about changing the correspondence address in a pending application, and TMEP §603.02(c) for information about changing the correspondence address after registration.

603.01(a) Correspondence in §66(a) Applications

The USPTO will send the first Office action in an application under §66(a) of the Trademark Act to the International Bureau of the World Intellectual Property Organization ("IB"). The IB will send it to the applicant. The USPTO will send second and subsequent Office actions directly to the applicant, at the correspondence address set forth in the request for extension of protection to the United States, or to the correspondence address provided in a subsequent communication filed in the USPTO. See TMEP §1904.02(e) for further information about Office actions in §66(a) applications.

The USPTO will accept a notice of change of the correspondence address in a §66(a) application or a registered extension of protection of an international registration to the United States, and will send correspondence to the new address. However, this will not change the representative designated in the international registration, to which the IB sends correspondence. A request to record a change of

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the name or address of the representative designated in the international registration must be filed with the IB; it cannot be filed through the USPTO. There are forms on the IB website at <http://www.wipo.int/madrid/en/>. See Madrid Protocol Common Reg. 36(i).

See TMEP §§1906 *et seq.* regarding requests to record changes with the IB.

603.02 Changing the Correspondence Address

To expedite processing, notices of change of correspondence address should be filed through TEAS, at www.uspto.gov/teas/index.html. When a notice is filed electronically, the USPTO receives it within seconds after filing, and immediately issues a confirmation of filing via e-mail. The TEAS form can be used to change the correspondence address on any application or registration that is currently active. The data from the form is inputted directly into the automated records of the USPTO. See TMEP §603.02(b) for information about how to change the correspondence address in multiple applications or registrations.

603.02(a) Changing the Correspondence Address Before Registration

Once the correspondence address is established for a particular application, it is not changed unless there is a written request by the applicant or the attorney of record to change the address. The mere transmittal of a response to an Office action bearing a new address for an applicant or an applicant's attorney does not effect a change in a correspondence address.

If an applicant is represented by an attorney ("A"), and another attorney ("B") later responds on behalf of the applicant and requests that correspondence be sent to B, B will be required to submit written authorization from the applicant for the requested change in correspondence address. Correspondence will continue to be sent to A until B submits the necessary authorization from the applicant. Attorney B cannot sign a request to change the correspondence address on behalf of the applicant. See TMEP §603.04 regarding processing of correspondence that is signed by someone other than the applicant or the applicant's designated attorney.

The USPTO will construe the following as a written request to change the correspondence address:

- (1) A new power of attorney, signed by someone authorized to bind the applicant (see TMEP §602.01), is filed, even if there is no revocation of a previous power of attorney (however, the filing of an "associate power of attorney" or similar document does not change the correspondence address); or

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- (2) The application is filed by a *pro se* applicant, and correspondence is subsequently filed that identifies the name and address of an attorney, either on the correspondence itself or on the transmittal letter that accompanies the correspondence, even if no power of attorney is filed.

In these two situations, the USPTO will change the correspondence address to the address of the new attorney. In all other situations, a written request to change the correspondence address, signed by the applicant, is required.

To expedite processing, the USPTO recommends that the notice of change of address be filed through TEAS, at www.uspto.gov/teas/index.html. The TEAS form can be used to change the correspondence address on any application or registration that is currently active. When the notice is filed electronically, the USPTO receives it within seconds after filing, and immediately issues a confirmation of filing via e-mail. The data from the form is inputted directly into the automated records of the USPTO. See TMEP §603.02(b) for information about how to change the correspondence address in multiple applications or registrations.

When a request to change the correspondence address is filed *on paper*, the USPTO manually enters the new correspondence address into its automated records and places the request in the application record, but does not send a confirmation or other acknowledgment of the request to change the correspondence address. The applicant may check the Trademark Applications and Registrations Retrieval (“TARR”) database at <http://tarr.uspto.gov> to determine whether the change of address has been entered into the automated records of the USPTO.

A change of correspondence address cannot be entered by examiner’s amendment.

When ownership of an application changes and the proper document is recorded in the Assignment Services Division, the USPTO will update its automated records to reflect the address of the assignee or the assignee’s attorney, even if the assignee does not specifically request a change of address.

The USPTO will not process a request to change the correspondence address in an abandoned application. When an applicant files a request to change the correspondence address in an abandoned application, the USPTO simply places the request in the record.

The USPTO will not undertake double correspondence with the applicant and the applicant’s attorney or with more than one attorney or representative.

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603.02(b) Changing the Correspondence Address in Multiple Applications or Registrations

A single TEAS form for recording a change of address, found at www.uspto.gov/teas/index.html, can be used to notice a change of address for more than one application or registration. The TEAS form can be used to change the correspondence address only on applications or registrations that are currently active.

603.02(c) Changing the Correspondence Address After Registration

To expedite processing, the USPTO recommends that the notice of change of address be filed through TEAS, at www.uspto.gov/teas/index.html. The TEAS form can be used to change the correspondence address on any registration that is currently active. When the notice is filed electronically, the USPTO receives it within seconds after filing, and immediately issues a confirmation of filing via e-mail. The data from the form is inputted directly into the USPTO's automated system.

When the owner of a registration files a request *on paper* to change the correspondence address after registration, the USPTO scans an image of the request into the record, but does not update the TRAM System unless the owner concurrently files a §8 or §15 affidavit, §9 renewal application, or request to amend or correct a registration under 15 U.S.C. §1057. If the owner wants the new address entered into the TRAM system, the owner must file the notice of change of address through TEAS.

When a §8 or §15 affidavit, §9 renewal application, or request to amend or correct a registration is filed through an attorney, the USPTO will update TRAM to indicate the name of the attorney who filed the affidavit, renewal application or request. If the owner of the registration does not have an attorney, the USPTO updates TRAM to indicate the owner's address as shown in the affidavit, renewal application or amendment.

603.03 Applicant Has Duty to Maintain Current and Accurate Correspondence Address

It is the applicant's responsibility to maintain a current and accurate correspondence address in its application. If the correspondence address changes, the USPTO must be promptly notified in writing, preferably through TEAS. 37 C.F.R. §2.18. This also applies to e-mail addresses, if the applicant has authorized the Office to send correspondence by e-mail (see TMEP §304.03).

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603.04 Processing Correspondence Signed by Someone Other Than the Applicant or the Applicant's Designated Attorney

During the prosecution of a trademark application, every action that is not signed by the applicant must be signed by a practitioner qualified under 37 C.F.R. §10.14 to practice before the USPTO in trademark cases. 37 C.F.R. §10.18(a). Any action that is so signed will be accepted regardless of whether the practitioner who has signed is the same person who signed previously submitted papers, and regardless of whether the practitioner has filed a power of attorney. 37 C.F.R. §2.17(c). However, if the signer is different, the USPTO will continue to send correspondence to the correspondence address already established unless and until there is a written request to change that address, signed by the applicant.

Example: If an application as originally filed is accompanied by a transmittal letter bearing the name and address of an attorney, the attorney's name and address will be entered into the records of the USPTO as the correspondence address (see TMEP §603.01). If a response to an Office action signed by a different attorney is subsequently filed, the USPTO will accept and act on the response, but will continue to send correspondence to the mailing address originally established until there is a written request to change that address.

See TMEP §§603.02 *et seq.* regarding requests to change the correspondence address.

The examining attorney should ensure that the person who signs each document, if not the applicant, is either an attorney authorized to practice before the USPTO (which normally can be presumed from the attorney's own statement or identification) or other authorized party. See TMEP §602 regarding persons who may practice before the USPTO in trademark matters, TMEP §602.03 regarding papers filed by unauthorized persons, and TMEP §§712.01 *et seq.* regarding the proper person to sign a response to an Office action.

603.05 Correspondence with Parties Not Domiciled in the United States

If an applicant, registrant or party to a proceeding before the USPTO has not clearly stated a preferred correspondence address, the USPTO will process correspondence as follows:

If an applicant, registrant or party to a proceeding before the USPTO has authorized a practitioner qualified to practice before the USPTO in trademark cases under 37 C.F.R. §10.14, the USPTO will send correspondence to that attorney only if: (1) the practitioner has a United States correspondence address, or (2) the practitioner resides in a foreign country but is qualified under 37 C.F.R. §10.14(c).

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Currently, Canadian attorneys are the only foreign attorneys recognized as meeting the qualification criteria in 37 C.F.R. §10.14(c) (see TMEP §602).

If the applicant, registrant or party is not represented by an attorney qualified under 37 C.F.R. §10.14, and the applicant/registrant/party has appointed a domestic representative, the USPTO will send correspondence to the domestic representative, unless the applicant/registrant/party designates in writing another correspondence address. However, the domestic representative is not authorized to prosecute an application or represent a party in a proceeding before the USPTO, unless the domestic representative is a practitioner qualified under 37 C.F.R. §10.14 to practice before the USPTO in trademark cases. 37 C.F.R. §2.24. See TMEP §604 regarding domestic representatives.

If the applicant, registrant or party is not represented by a practitioner qualified under 37 C.F.R. §10.14, and the applicant/registrant/party does not designate a domestic representative, the USPTO will send correspondence directly to the applicant/registrant/party's foreign address, unless the applicant/registrant/party designates in writing another correspondence address.

See TMEP §603.01(a) regarding correspondence in §66(a) applications.

604 Designation of Domestic Representative by Parties Not Domiciled in the United States

An applicant, registrant, or party to a proceeding before the USPTO who is not domiciled in the United States may file a document designating the name and address of a domestic representative on whom may be served notices or process in proceedings affecting the mark. 15 U.S.C. §§1051(e), 1058(f), 1059(c), 1060(b), and 1141h(d). The USPTO encourages parties who do not reside in the United States to designate domestic representatives, but it is not mandatory. If the applicant, registrant, or party does not designate a domestic representative, the USPTO will not require a designation.

To expedite processing, the USPTO recommends that designations of domestic representative be filed through TEAS, at <http://www.uspto.gov/teas/index.html>. TEAS can also be used to revoke a designation of a domestic representative.

The designation is not the same as a power of attorney. The designation serves a different purpose, namely, to bring foreign applicants, registrants and parties under the jurisdiction of the United States legal system. The designation of a domestic representative does not authorize the person designated to prosecute the application or to represent a party in a proceeding before the USPTO. 37 C.F.R. §2.24. Similarly, a power of attorney does not serve as a designation of a domestic representative unless the power of attorney specifically states that the attorney is

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also the domestic representative on whom may be served notices or process in proceedings affecting the mark.

If a party designates a domestic representative, the designation should include the name and address of the person designated, and a clear statement that the party intends to designate this person as a domestic representative upon whom notices or process affecting the mark may be served. The designation must be in writing. A person who is properly authorized to sign a designation of domestic representative is:

- (1) A person with legal authority to bind the applicant or party; or
- (2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant or party; or
- (3) An attorney as defined in 37 C.F.R. §10.1(c) who has an actual written or verbal power of attorney or an implied power of attorney from the applicant or party.

TMEP §804.04. See TMEP §804.05 regarding signature of documents transmitted electronically.

The person designated as a domestic representative may be a natural person or a juristic person as defined in 15 U.S.C. §1127.

If an applicant, registrant or party to a proceeding before the USPTO does not file a document designating a domestic representative, or if the last person designated cannot be found at the address given in the designation, then notices or process in proceedings affecting the mark may be served on the Director. 15 U.S.C. §§1051(e), 1058(f), 1059(c), 1060(b), and 1141h(d).

See TMEP §603.05 regarding correspondence with parties who are not domiciled in the United States.